

REMARKS

I. Status Of Claims

Claims 1-21 are pending.

Claims 1-21 stand rejected.

Claims 1, 7,8,21,22,23,24, 25 have been amended.

Claim 26 is new.

No new matter has been added.

II. Remarks/Arguments

Reconsideration of the application in view of the following remarks is requested. No new matter has been added by the amendments to the claims. Applicant further submits that the amendments made are not related to patentability and do not alter or limit the substance of the subject matter claimed. The previous amendment dated February 17, 2005 addressed the 35 USC 101 rejection.

III. Rejection Under 35 USC §103

The examiner has rejected claims 1-21 under 35 USC 101 as being directed to non-statutory subject matter as well as under 35 USC §103(a) as being unpatentable over Mutch's article Risk & Insurance; Technology: "Unlocking the Neural Network" (Jan. 1999) in view of Hann's article High-tech sleuths (Nov. 1998).

Mutch respectfully does not disclose "selecting claims on the basis of the base score which demonstrate at least a given probability of expected subrogation recovery dependent upon the received data; and automatically identifying risk factors associated with the claim for each of the select claims..."

The test for obviousness fails because neither prior art reference or combined references teach or suggest all the claim limitations in the present invention. Respectfully, the fact that an article (in this case in connection with neural networks and not the subject of the present invention) uses the word "computerized" does not remove the requirement that the claimed

Application Serial No. 09/676,391
Response to Office Action of December 2, 2004
Atty. Docket No. Hartford-3

elements of the present invention must be present in one of the references. Neither reference alone or in combination discloses the claims as modified. Each of these sequences are important to subrogation scoring success. Neither Hann nor Mutch discloses these limitations and consequently there would be no motivation by one skill in the art at the time of the invention to include these sequences. Freeman does not include them because they would not apply in the insurance system it disclosed. Such calculations as base score only apply to subrogation and this feature is missing from the references.

In Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc., 231 F. 3d 1339, 56 USPQ2d 1641 (Fed. Cir. 2000), the court reflected on the importance of suggestion or motivation to combine references in an obviousness analysis by stating:

an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *Id.* at 1644, quoting *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

With regard to claims dependent from claim 1, these claims were rejected based in part on the same reason for rejecting claim 1. However, having shown that the present invention, as recited in claim 1, is non-obvious in view of the references cited, applicant submits that these dependent claims are also not obvious, and are allowable, by virtue of their dependence upon an allowable base claim.

Applicant submits that the reasons for the examiner's rejection of the claims have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration,

Application Serial No. 09/676,391
Response to Office Action of December 2, 2004
Atty. Docket No. Hartford-3

withdrawal of the rejection and allowance of the claims.

VI. Conclusion

Having addressed the examiner's rejection of the claims under 35 U.S.C. § 101 and 35 U.S.C. § 103, and in view of the previously submitted Office Action dated February 17, 2005 and the Examiner Telephone Interview on April 5, 2005, applicant submits that the reasons for the examiner's rejection have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the objection and rejection and that a Notice of Allowance regarding claims 1-26 be issued.

If the examiner believes that the prosecution of this matter may be advanced by a telephone call, the examiner is invited to contact applicant's attorney at the telephone number indicated below.

Application Serial No. 09/676,391
Response to Office Action of December 2, 2004
Atty. Docket No. Hartford-3

V. Fees

The Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to Duane Morris LLP deposit account **04-1679**.

Respectfully submitted,

Dated: 4/12/05


Joseph R. Carvalko
Reg. No. 29,779

DUANE MORRIS LLP
380 Lexington Avenue
New York, NY 10168
(212) 692 1052
(212) 692 1020
CUSTOMER NO. 42109